

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#32
Sup. Declaration
12/22/97
Moley

Application of:

Applicant: Jack Beery
Serial No.: 08/116,019
Filed: September 2, 1993
Title: TELEVISION RECEIVER HAVING MEMORY CONTROL FOR
TUNE-BY-LABEL FEATURE
Examiner: N. Flynn
Art Unit: 2602
Reissue of: U.S. Patent No. 5,045,947
Issued: September 3, 1991
Docket No.: JB-2.3

Assistant Commissioner for Patents
Washington, DC 20231

SUBSTITUTE DECLARATION OF THOMAS A. BOSHINSKI
IN SUPPORT OF REISSUE

Dear sir:

I, Thomas A. Boshinski, hereby declare as follows:

1. I am a patent attorney registered to practice before the United States Patent and Trademark Office, Registration Number 30,611.
2. On behalf of the applicant in this application, Jack Beery, I prepared a patent application for an invention entitled "Apparatus for Controlling a Television Receiver," which application was filed with the Patent and Trademark Office on May 31, 1989. I also prepared on behalf of Beery a further patent application for a television receiver control apparatus, which application was filed on April 26, 1990 as a continuation-in-part of the earlier application. I personally typed the specifications for both applications.

3. I also represented Mr. Beery in the prosecution of both of the applications. The earlier application issued in November 1991 as U.S. Patent No. 5,068,734, and the continuation-in-part application issued in September 1991 as U.S. Patent No. 5,045,947.

4. On behalf of Mr. Beery, I prepared and filed on September 3, 1993, the above-identified reissue application to reissue Mr. Beery's '947 patent. I have prosecuted such application on Mr. Beery's behalf.

5. I have reviewed the Third Substitute Declaration (Reissue) executed by Mr. Beery on November 3, 1997. I make the following statements with respect to the various claims sought to be added to the '947 patent in the reissue application, and to the various errors in the specification sought to be corrected in the reissue application.

Errors in the Claims

Claim 5

6. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility of presenting in the application a method claim. It did not occur to me, and I inadvertently failed to appreciate, that a method claim in accord with claim 5 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

7. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions included

a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested generally by either Mr. Hokanson or Mr. Bright (I do not remember which) that Mr. Beery could have presented a method claim as a way of protecting the invention, and that Mr. Beery should consider the filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

8. At about the same time, I was prosecuting on Mr. Beery's behalf a reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Beery and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Beery and I discussed during this time that the invention could be defined in terms of a method claim, although no such claim had been presented in the application for the '947 patent.

9. Mr. Beery asked me to consider whether a reissue application for the '947 patent could be filed, and if so, to prepare the necessary papers for its filing.

10. Sometime during July and August of 1993, I prepared for Mr. Beery's review a claim like that presented as claim 5 in this application. Mr. Beery, after reviewing this claim, asked me to include this claim in the application for reissue of the '947 patent which I was preparing at this time.

Claim 7

11. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the application to a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element. It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 7 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

12. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions included a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that Mr. Beery could have presented claims which did not include the tuning means as an element of the claims, and that Mr. Beery should consider the filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

13. At about the same time, I was prosecuting on Mr. Beery's behalf a reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Beery and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Beery and I discussed during this time that the tuning means was not a necessary limitation of claims directed to his invention, although no such claims had been presented in the application for the '947 patent.

14. Mr. Beery asked me to consider whether a reissue application for the '947 patent could be filed, and if so, to prepare the necessary papers for its filing.

15. Sometime during July and August of 1993, I prepared for Mr. Beery's review a claim like that presented as claim 7 in this application. Mr. Beery, after reviewing this claim, asked me to include this claim in the application for reissue of the '947 patent which I was preparing at this time.

Claim 8

16. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the application for a control apparatus for a television receiver in which the apparatus could store channel designations in an ordered cue as determined by the operator. It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 8 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

17. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions included a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that Mr. Beery could have presented claims to the feature for storing channel designations in an ordered cue independent of the operator-selected channel designation feature, and that Mr. Beery should consider the filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

18. At about the same time, I was prosecuting on Mr. Beery's behalf a reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Beery and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Beery and I discussed during this time that the feature for storing channel

designations in an ordered cue could have been claimed independently, although no such claims had been presented in the application for the '947 patent.

19. Mr. Beery asked me to consider whether a reissue application for the '947 patent could be filed, and if so, to prepare the necessary papers for its filing.

20. Sometime during July and August of 1993, I prepared for Mr. Beery's review a claim like that presented as claim 8 in this application. Mr. Beery, after reviewing this claim, asked me to include this claim in the application for reissue of the '947 patent which I was preparing at this time.

Claim 9

21. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the application for a control apparatus for a television receiver in which the apparatus could store channel designations in a plurality of ordered cues. It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 9 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

22. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions included a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which)

that Mr. Beery could have presented claims to features of his invention which were independent of the operator-selected channel designation feature, and that Mr. Beery should consider the filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

23. In the spring of 1993, Mr. Beery informed me of certain television sets sold by Hitachi Home Electronics (America), Inc. which he believed included a "favorite channel" feature in which channel designations were stored in multiple cues. I discussed with Mr. Beery whether this feature could be claimed independently of the operator-selected channel designation feature. I advised Mr. Beery that such claims could have been presented in the application for my '947 patent.

24. Mr. Beery asked me to consider whether a reissue application for the '947 patent could be filed, and if so, to prepare the necessary papers for its filing.

25. Sometime during July and August of 1993, I prepared for Mr. Beery's review a claim like that presented as claim 9 in this application. Mr. Beery, after reviewing this claim, asked me to include this claim in the application for reissue of the '947 patent which I was preparing at this time.

Claim 10

26. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the application for a control apparatus for a television receiver in which the apparatus could store channel designations in a plurality of ordered cues, and which includes means for generating a cue selection signal. It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 10 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

27. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery.

28. In the spring of 1993, Mr. Beery informed me of certain television sets sold by Hitachi Home Electronics (America), Inc. which he believed included a "favorite channel" feature in which channel designations were stored in multiple cues. I discussed with Mr. Beery whether this feature could be claimed independently of the operator-selected channel designation feature. I advised Mr. Beery that such claims could have been presented in the application for my '947 patent.

29. Sometime during July and August of 1993, I prepared for Mr. Beery's review a claim like that presented as claim 9 in this application. While preparing that claim, I focused on the multiple cue feature of Mr. Beery's invention, and realized that the means for generating a cue selection signal was also a part of his invention, and that a claim to this aspect of the invention could have been presented in the application for the '947 patent but was not. Accordingly, I also prepared claim 10 which I submitted to him for review. Mr. Beery then asked me to include this claim in the application for reissue of the '947 patent which I was preparing at this time.

Claim 11

30. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the application for a control apparatus for a television receiver that did not include a tuner means

for the television receiver as an element. It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 11 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

31. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions included a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that Mr. Beery could have presented claims which did not include the tuning means as an element of the claims, and that Mr. Beery should consider the filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

32. At about the same time, I was prosecuting on Mr. Beery's behalf a reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Beery and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Beery and I discussed during this time that the tuning means was not a necessary limitation of claims directed to his invention, although no such claims had been presented in the application for the '947 patent.

33. In August 1993, Mr. Beery brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with his '734 patent.

34. In September 1993, a reissue application for the '947 patent was filed.

35. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Beery and I discussed the claims of the '947 patent as I prepared a response to the Office action. At the same time, Mr. Beery, Mr. Hokanson and I continued to review his invention as described in the '947 patent in connection with the prosecution of the Gemstar litigation. As a result of that review, and while drafting a response to the Office action, I realized that a claim like that presented as claim 11 in this application could have been presented in the application for the '947 patent. I discussed this realization with Mr. Beery, who then asked me to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

Claim 12

36. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the application for a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element. It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 12 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

37. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions

included a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that Mr. Beery could have presented claims which did not include the tuning means as an element of the claims, and that Mr. Beery should consider the filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

38. At about the same time, I was prosecuting on Mr. Beery's behalf a reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Beery and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Beery and I discussed during this time that the tuning means was not a necessary limitation of claims directed to his invention, although no such claims had been presented in the application for the '947 patent.

39. In August 1993, Mr. Beery brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with his '734 patent.

40. In September 1993, a reissue application for the '947 patent was filed.

41. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Beery and I discussed the claims of the '947 patent as I prepared a response to the Office action. At the same time, Mr. Beery, Mr. Hokanson and I continued to review his invention as described in the '947 patent in connection with the prosecution of the Gemstar litigation. As a result of that review, and while drafting a response to the Office action, I realized that a claim like that presented as claim 12 in this application could have been presented in the application for the '947 patent. I discussed this realization with Mr. Beery, who then asked me to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

Claim 13

42. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the application for a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element. It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 13 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

43. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions included a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that Mr. Beery could have presented claims which did not include the tuning means as an element of the claims, and that Mr. Beery should consider the filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

44. At about the same time, I was prosecuting on Mr. Beery's behalf a reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Beery and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Beery and I discussed during this time that the tuning means was not a necessary limitation of claims directed to his invention, although no such claims had been presented in the application for the '947 patent.

45. In August 1993, Mr. Beery brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with his '734 patent.

46. In September 1993, a reissue application for the '947 patent was filed.

47. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Beery and I discussed the claims of the '947 patent as I prepared a response to the Office action. At the same time, Mr. Beery, Mr. Hokanson and I continued to review his invention as described in the '947 patent in connection with the prosecution of the Gemstar litigation. As a result of that review, and while drafting a response to the Office action, I realized that a claim like that presented as claim 13 in this application could have been presented in the application for the '947 patent. I discussed this realization with Mr. Beery, who then asked me to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

Claim 14

48. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the application for a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element. It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 14 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

49. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson,

and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions included a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that Mr. Beery could have presented claims which did not include the tuning means as an element of the claims, and that Mr. Beery should consider the filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

50. At about the same time, I was prosecuting on Mr. Beery's behalf a reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Beery and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Beery and I discussed during this time that the tuning means was not a necessary limitation of claims directed to his invention, although no such claims had been presented in the application for the '947 patent.

51. In August 1993, Mr. Beery brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with his '734 patent.

52. In September 1993, a reissue application for the '947 patent was filed.

53. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Beery and I discussed the claims of the '947 patent as I prepared a response to the Office action. At the same time, Mr. Beery, Mr. Hokanson and I continued to review his invention as described in the '947 patent in connection with the prosecution of the Gemstar litigation. As a result of that review, and while drafting a response to the Office action, I realized that a claim like that presented as claim 14 in this application could have been presented in the application for the

'947 patent. I discussed this realization with Mr. Beery, who then asked me to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

Claim 15

54. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the application for a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element. It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 15 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

55. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions included a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that Mr. Beery could have presented claims which did not include the tuning means as an element of the claims, and that Mr. Beery should consider the filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

56. At about the same time, I was prosecuting on Mr. Beery's behalf a reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination

which caused Mr. Beery and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Beery and I discussed during this time that the tuning means was not a necessary limitation of claims directed to his invention, although no such claims had been presented in the application for the '947 patent.

57. In August 1993, Mr. Beery brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with his '734 patent.

58. In September 1993, a reissue application for the '947 patent was filed.

59. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Beery and I discussed the claims of the '947 patent as I prepared a response to the Office action. At the same time, Mr. Beery, Mr. Hokanson and I continued to review his invention as described in the '947 patent in connection with the prosecution of the Gemstar litigation. As a result of that review, and while drafting a response to the Office action, I realized that a claim like that presented as claim 15 in this application could have been presented in the application for the '947 patent. I discussed this realization with Mr. Beery, who then asked me to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

Claim 16

60. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the application for a control apparatus for a television receiver in which the apparatus could store channel designations in a plurality of ordered cues. It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 16 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

61. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions included a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that Mr. Beery could have presented claims to the feature for storing channel designations in an ordered cue independent of the operator-selected channel designation feature, and that Mr. Beery should consider the filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

62. At about the same time, I was prosecuting on Mr. Beery's behalf a reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Beery and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Beery and I discussed during this time that the feature for storing channel designations in multiple ordered cues could have been claimed independently, although no such claims had been presented in the application for the '947 patent.

63. In August 1993, Mr. Beery brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with his '734 patent.

64. In September 1993, a reissue application for the '947 patent was filed.

65. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Beery and

I discussed the claims of the '947 patent as I prepared a response to the Office action. At the same time, Mr. Beery, Mr. Hokanson and I continued to review his invention as described in the '947 patent in connection with the prosecution of the Gemstar litigation. As a result of that review, and while drafting a response to the Office action, I realized that a claim like that presented as claim 16 in this application could have been presented in the application for the '947 patent. I discussed this realization with Mr. Beery, who then asked me to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

Claim 17

66. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the application for a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element. I further did not claim in the '947 patent a control apparatus in which the processor performed operations "in response to" the presence of a particular signal. It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 17 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

67. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions included a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which)

that Mr. Beery could have presented claims which did not include the tuning means as an element of the claims, and that Mr. Beery should consider the filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

68. At about the same time, I was prosecuting on Mr. Beery's behalf a reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Beery and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Beery and I discussed during this time that the tuning means was not a necessary limitation of claims directed to his invention, although no such claims had been presented in the application for the '947 patent.

69. In August 1993, Mr. Beery brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with his '734 patent.

70. In September 1993, a reissue application for the '947 patent was filed.

71. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Beery and I discussed the claims of the '947 patent as I prepared a response to the Office action.

72. At approximately this same time (early 1994), Mr. Beery and I learned through Mr. Hokanson that Gemstar in the litigation had advanced the argument that its accused device did not infringe as a result of language "upon receipt of" which appeared in the claims of the '734 patent. Specifically, the Gemstar product received a data set which was representative of a channel select designation. However, because the Gemstar device is for the purpose of later recording programs on a VCR, some time would pass before the received data set was used to tune the channel in question. This separation in time, Gemstar argued, did not fall within the scope of the language "upon receipt of." While I did not then, and do not now, believe the

Gemstar interpretation to be correct, Mr. Hokanson and I suggested to Mr. Beery that broader claims could have been presented in the application for the '947 patent using language such as "in response to," which language would be broader than the language "upon receipt of."

73. Mr. Beery then asked me to include a claim like claim 17 in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

Claim 18

74. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the application for a control apparatus for a television receiver in which the apparatus could store, for each of the channel tuning designations, a channel select designation which was identical thereto, and in which the processor performed operations "in response to" the presence of a particular signal. It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 18 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

75. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions included a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that Mr. Beery could have presented additional claims in one or the other of these applications,

and that Mr. Beery should consider the filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

76. In September 1993, a reissue application for the '947 patent was filed.

77. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Beery and I discussed the claims of the '947 patent as I prepared a response to the Office action.

78. At approximately this same time (early 1994), Mr. Beery and I learned through Mr. Hokanson that Gemstar in the litigation had advanced the argument that its accused device did not infringe as a result of language "upon receipt of" which appeared in the claims of the '734 patent. Specifically, the Gemstar product received a data set which was representative of a channel select designation. However, because the Gemstar device is for the purpose of later recording programs on a VCR, some time would pass before the received data set was used to tune the channel in question. This separation in time, Gemstar argued, did not fall within the scope of the language "upon receipt of." While I did not then, and do not now, believe the Gemstar interpretation to be correct, Mr. Hokanson and I suggested to Mr. Beery that broader claims could have been presented in the application for the '947 patent using language such as "in response to," which language would be broader than the language "upon receipt of."

79. Mr. Beery then asked me to include a claim like claim 18 in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

Claim 19

80. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the application for a control apparatus for a television receiver in which the apparatus receives a multi-channel input including a plurality of active channels, and in which the memory stores a

channel select designation for each of the active channels which is identical thereto. It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 19 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

81. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions included a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that Mr. Beery could have presented additional claims in one or the other of these applications, and that Mr. Beery should consider the filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

82. In September 1993, a reissue application for the '947 patent was filed.

83. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Beery and I discussed the claims of the '947 patent as I prepared a response to the Office action.

84. At approximately this same time (early 1994), Mr. Beery and I learned through Mr. Hokanson that Gemstar in the litigation had advanced the argument that its accused device did not infringe as a result of language "upon receipt of" which appeared in the claims of the '734 patent. Specifically, the Gemstar product received a data set which was representative of a

channel select designation. However, because the Gemstar device is for the purpose of later recording programs on a VCR, some time would pass before the received data set was used to tune the channel in question. This separation in time, Gemstar argued, did not fall within the scope of the language "upon receipt of." While I did not then, and do not now, believe the Gemstar interpretation to be correct, Mr. Hokanson and I suggested to Mr. Beery that broader claims could have been presented in the application for the '947 patent using language such as "in response to," which language would be broader than the language "upon receipt of."

85. Mr. Beery then asked me to include a claim like claim 19 in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

Claim 21

86. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the application for a control apparatus for a television receiver in which the apparatus could store channel designations in an ordered cue as determined by the operator, and in which the processor performed operations "in response to" the presence of a particular signal. It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 21 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

87. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions

included a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that Mr. Beery could have presented claims to the feature for storing channel designations in an ordered cue independent of the operator-selected channel designation feature, and that Mr. Beery should consider the filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

88. At about the same time, I was prosecuting on Mr. Beery's behalf a reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Beery and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Beery and I discussed during this time that the feature for storing channel designations in an ordered cue could have been claimed independently, although no such claims had been presented in the application for the '947 patent.

89. In September 1993, a reissue application for the '947 patent was filed.

90. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Beery and I discussed the claims of the '947 patent as I prepared a response to the Office action.

91. At approximately this same time (early 1994), Mr. Beery and I learned through Mr. Hokanson that Gemstar in the litigation had advanced the argument that its accused device did not infringe as a result of language "upon receipt of" which appeared in the claims of the '734 patent. Specifically, the Gemstar product received a data set which was representative of a channel select designation. However, because the Gemstar device is for the purpose of later recording programs on a VCR, some time would pass before the received data set was used to tune the channel in question. This separation in time, Gemstar argued, did not fall within the scope of the language "upon receipt of." While I did not then, and do not now, believe the Gemstar interpretation to be correct, Mr. Hokanson and I suggested to Mr. Beery that broader

claims could have been presented in the application for the '947 patent using language such as "in response to," which language would be broader than the language "upon receipt of."

92. Mr. Beery then asked me to include a claim like claim 21 in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

Claim 22

93. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the application for a control apparatus for a television receiver in which the apparatus could store channel designations in a plurality of ordered cues, and in which the processor performed operations "in response to" the presence of a particular signal. It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 22 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

94. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions included a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that Mr. Beery could have presented claims to the feature for storing channel designations in multiple ordered cues independent of the operator-selected channel designation feature, and that

Mr. Beery should consider the filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

95. At about the same time, I was prosecuting on Mr. Beery's behalf a reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Beery and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Beery and I discussed during this time that the feature for storing channel designations in multiple ordered cues could have been claimed independently, although no such claims had been presented in the application for the '947 patent.

96. In September 1993, a reissue application for the '947 patent was filed.

97. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Beery and I discussed the claims of the '947 patent as I prepared a response to the Office action.

98. At approximately this same time (early 1994), Mr. Beery and I learned through Mr. Hokanson that Gemstar in the litigation had advanced the argument that its accused device did not infringe as a result of language "upon receipt of" which appeared in the claims of the '734 patent. Specifically, the Gemstar product received a data set which was representative of a channel select designation. However, because the Gemstar device is for the purpose of later recording programs on a VCR, some time would pass before the received data set was used to tune the channel in question. This separation in time, Gemstar argued, did not fall within the scope of the language "upon receipt of." While I did not then, and do not now, believe the Gemstar interpretation to be correct, Mr. Hokanson and I suggested to Mr. Beery that broader claims could have been presented in the application for the '947 patent using language such as "in response to," which language would be broader than the language "upon receipt of."

99. Mr. Beery then asked me to include a claim like claim 22 in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

Claim 23

100. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the application for a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element, and in which the processor performed operations "in response to" the presence of a particular signal. It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 23 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

101. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions included a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that Mr. Beery could have presented claims which did not include the tuning means as an element of the claims, and that Mr. Beery should consider the filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

102. At about the same time, I was prosecuting on Mr. Beery's behalf a reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination

which caused Mr. Beery and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Beery and I discussed during this time that the tuning means was not a necessary limitation of claims directed to his invention, although no such claims had been presented in the application for the '947 patent.

103. In September 1993, a reissue application for the '947 patent was filed.

104. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Beery and I discussed the claims of the '947 patent as I prepared a response to the Office action.

105. At approximately this same time (early 1994), Mr. Beery and I learned through Mr. Hokanson that Gemstar in the litigation had advanced the argument that its accused device did not infringe as a result of language "upon receipt of" which appeared in the claims of the '734 patent. Specifically, the Gemstar product received a data set which was representative of a channel select designation. However, because the Gemstar device is for the purpose of later recording programs on a VCR, some time would pass before the received data set was used to tune the channel in question. This separation in time, Gemstar argued, did not fall within the scope of the language "upon receipt of." While I did not then, and do not now, believe the Gemstar interpretation to be correct, Mr. Hokanson and I suggested to Mr. Beery that broader claims could have been presented in the application for the '947 patent using language such as "in response to," which language would be broader than the language "upon receipt of."

106. Mr. Beery then asked me to include a claim like claim 23 in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

Claim 24

107. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the

application for a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element, and in which the processor performed operations "in response to" the presence of a particular signal. It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 24 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

108. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions included a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that Mr. Beery could have presented claims which did not include the tuning means as an element of the claims, and that Mr. Beery should consider the filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

109. At about the same time, I was prosecuting on Mr. Beery's behalf a reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Beery and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Beery and I discussed during this time that the tuning means was not a necessary limitation of claims directed to his invention, although no such claims had been presented in the application for the '947 patent.

110. In August 1993, Mr. Beery brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with his '734 patent.

111. In September 1993, a reissue application for the '947 patent was filed.

112. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Beery and I discussed the claims of the '947 patent as I prepared a response to the Office action.

113. At approximately this same time (early 1994), Mr. Beery and I learned through Mr. Hokanson that Gemstar in the litigation had advanced the argument that its accused device did not infringe as a result of language "upon receipt of" which appeared in the claims of the '734 patent. Specifically, the Gemstar product received a data set which was representative of a channel select designation. However, because the Gemstar device is for the purpose of later recording programs on a VCR, some time would pass before the received data set was used to tune the channel in question. This separation in time, Gemstar argued, did not fall within the scope of the language "upon receipt of." While I did not then, and do not now, believe the Gemstar interpretation to be correct, Mr. Hokanson and I suggested to Mr. Beery that broader claims could have been presented in the application for the '947 patent using language such as "in response to," which language would be broader than the language "upon receipt of."

114. Mr. Beery then asked me to include a claim like claim 24 in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

Claim 25

115. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the application for a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element, and in which the processor performed operations "in

response to" the presence of a particular signal. It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 25 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

116. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions included a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that Mr. Beery could have presented claims which did not include the tuning means as an element of the claims, and that Mr. Beery should consider the filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

117. At about the same time, I was prosecuting on Mr. Beery's behalf a reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Beery and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Beery and I discussed during this time that the tuning means was not a necessary limitation of claims directed to his invention, although no such claims had been presented in the application for the '947 patent.

118. In August 1993, Mr. Beery brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with his '734 patent.

119. In September 1993, a reissue application for the '947 patent was filed.

120. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Beery and I discussed the claims of the '947 patent as I prepared a response to the Office action.

121. At approximately this same time (early 1994), Mr. Beery and I learned through Mr. Hokanson that Gemstar in the litigation had advanced the argument that its accused device did not infringe as a result of language "upon receipt of" which appeared in the claims of the '734 patent. Specifically, the Gemstar product received a data set which was representative of a channel select designation. However, because the Gemstar device is for the purpose of later recording programs on a VCR, some time would pass before the received data set was used to tune the channel in question. This separation in time, Gemstar argued, did not fall within the scope of the language "upon receipt of." While I did not then, and do not now, believe the Gemstar interpretation to be correct, Mr. Hokanson and I suggested to Mr. Beery that broader claims could have been presented in the application for the '947 patent using language such as "in response to," which language would be broader than the language "upon receipt of."

122. Mr. Beery then asked me to include a claim like claim 25 in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

Claim 26

123. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the application for a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element, and in which the processor performed operations "in response to" the presence of a particular signal. It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 26 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

124. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions included a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that Mr. Beery could have presented claims which did not include the tuning means as an element of the claims, and that Mr. Beery should consider the filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

125. At about the same time, I was prosecuting on Mr. Beery's behalf a reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Beery and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Beery and I discussed during this time that the tuning means was not a necessary limitation of claims directed to his invention, although no such claims had been presented in the application for the '947 patent.

126. In August 1993, Mr. Beery brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with his '734 patent.

127. In September 1993, a reissue application for the '947 patent was filed.

128. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Beery and I discussed the claims of the '947 patent as I prepared a response to the Office action.

129. At approximately this same time (early 1994), Mr. Beery and I learned through Mr. Hokanson that Gemstar in the litigation had advanced the argument that its accused device did not infringe as a result of language "upon receipt of" which appeared in the claims of the '734 patent. Specifically, the Gemstar product received a data set which was representative of a channel select designation. However, because the Gemstar device is for the purpose of later recording programs on a VCR, some time would pass before the received data set was used to tune the channel in question. This separation in time, Gemstar argued, did not fall within the scope of the language "upon receipt of." While I did not then, and do not now, believe the Gemstar interpretation to be correct, Mr. Hokanson and I suggested to Mr. Beery that broader claims could have been presented in the application for the '947 patent using language such as "in response to," which language would be broader than the language "upon receipt of."

130. Mr. Beery then asked me to include a claim like claim 26 in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

Claim 27

131. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the application for a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element, and in which the processor performed operations "in response to" the presence of a particular signal. It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 27 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

132. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions included a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that Mr. Beery could have presented claims which did not include the tuning means as an element of the claims, and that Mr. Beery should consider the filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

133. At about the same time, I was prosecuting on Mr. Beery's behalf a reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Beery and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Beery and I discussed during this time that the tuning means was not a necessary limitation of claims directed to his invention, although no such claims had been presented in the application for the '947 patent.

134. In August 1993, Mr. Beery brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with his '734 patent.

135. In September 1993, a reissue application for the '947 patent was filed.

136. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Beery and I discussed the claims of the '947 patent as I prepared a response to the Office action.

137. At approximately this same time (early 1994), Mr. Beery and I learned through Mr. Hokanson that Gemstar in the litigation had advanced the argument that its accused device did not infringe as a result of language "upon receipt of" which appeared in the claims of the '734 patent. Specifically, the Gemstar product received a data set which was representative of a channel select designation. However, because the Gemstar device is for the purpose of later recording programs on a VCR, some time would pass before the received data set was used to tune the channel in question. This separation in time, Gemstar argued, did not fall within the scope of the language "upon receipt of." While I did not then, and do not now, believe the Gemstar interpretation to be correct, Mr. Hokanson and I suggested to Mr. Beery that broader claims could have been presented in the application for the '947 patent using language such as "in response to," which language would be broader than the language "upon receipt of."

138. Mr. Beery then asked me to include a claim like claim 27 in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

Claim 28

139. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the application for a control apparatus for a television receiver in which the apparatus could store channel designations in a plurality of ordered cues, and in which the processor performed operations "in response to" the presence of a particular signal. It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 28 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

140. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions included a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that Mr. Beery could have presented claims to the feature for storing channel designations in an ordered cue independent of the operator-selected channel designation feature, and that Mr. Beery should consider the filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

141. At about the same time, I was prosecuting on Mr. Beery's behalf a reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Beery and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Beery and I discussed during this time that the feature for storing channel designations in multiple ordered cues could have been claimed independently, although no such claims had been presented in the application for the '947 patent.

142. In August 1993, Mr. Beery brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with his '734 patent.

143. In September 1993, a reissue application for the '947 patent was filed.

144. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Beery and I discussed the claims of the '947 patent as I prepared a response to the Office action.

145. At approximately this same time (early 1994), Mr. Beery and I learned through Mr. Hokanson that Gemstar in the litigation had advanced the argument that its accused device did not infringe as a result of language "upon receipt of" which appeared in the claims of the '734 patent. Specifically, the Gemstar product received a data set which was representative of a channel select designation. However, because the Gemstar device is for the purpose of later recording programs on a VCR, some time would pass before the received data set was used to tune the channel in question. This separation in time, Gemstar argued, did not fall within the scope of the language "upon receipt of." While I did not then, and do not now, believe the Gemstar interpretation to be correct, Mr. Hokanson and I suggested to Mr. Beery that broader claims could have been presented in the application for the '947 patent using language such as "in response to," which language would be broader than the language "upon receipt of."

146. Mr. Beery then asked me to include a claim like claim 28 in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

Claim 30

147. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the application for a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element, and which included as elements "a tuner," "a memory," "an operator-actuated control device," and "a processor." It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 30 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

148. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions included a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that Mr. Beery could have presented claims which did not include the tuner as an element of the claims, and that Mr. Beery should consider the filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

149. At about the same time, I was prosecuting on Mr. Beery's behalf a reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Beery and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Beery and I discussed during this time that the tuner was not a necessary limitation of claims directed to his invention, although no such claims had been presented in the application for the '947 patent.

150. In August 1993, Mr. Beery brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with his '734 patent.

151. In September 1993, a reissue application for the '947 patent was filed.

152. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Beery and I discussed the claims of the '947 patent as I prepared a response to the Office action.

153. Also during February of 1994, the CAFC issued its *In re Donaldson* decision (29 USPQ2d 1845), which required the PTO to interpret "means plus function" claim language as limited to the specific embodiment disclosed and equivalents thereof. Much attention was paid to this decision in the patent bar, and I recall that it was suggested by some patent practitioners and commentators that "means-plus-function" language should be avoided, or at least that some claims which did not use "means-plus-function" language be included. I discussed this decision, and the law relating to "means-plus-function" claim elements generally with my own patent colleagues, and specifically with trial counsel as it related to the claims of the '734 and '947 patents. I concluded that broader claims would result from avoidance of these limitations, and realized that I had erroneously not presented claims during the prosecution of the '947 patent, although such claims could have been.

154. I explained to Mr. Beery that broader claims could result from avoidance of "means-plus-function" limitations, and that a claim which did not include "means-plus-function" limitations erroneously had not been presented during the prosecution of the '947 patent. I further recognized and suggested to Mr. Beery that a claim like claim 30 could have been presented during the prosecution of the '947 patent. Mr. Beery thereafter asked me to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

Claim 31

155. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the application for a control apparatus for a television receiver in which the apparatus could store channel designations in an ordered cue as determined by the operator, and which included as elements "a tuner," "a memory," "an operator-actuated control device," and "a processor." It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 31 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

156. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions included a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that Mr. Beery could have presented claims to the feature for storing channel designations in an ordered cue independent of the operator-selected channel designation feature, and that Mr. Beery should consider the filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

157. At about the same time, I was prosecuting on Mr. Beery's behalf a reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Beery and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Beery and I discussed during this time that the feature for storing channel designations in an ordered cue could have been claimed independently, although no such claims had been presented in the application for the '947 patent.

158. In August 1993, Mr. Beery brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with his '734 patent.

159. In September 1993, a reissue application for the '947 patent was filed.

160. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Beery and I discussed the claims of the '947 patent as I prepared a response to the Office action.

161. Also during February of 1994, the CAFC issued its *In re Donaldson* decision (29 USPQ2d 1845), which required the PTO to interpret "means plus function" claim language as limited to the specific embodiment disclosed and equivalents thereof. Much attention was paid to this decision in the patent bar, and I recall that it was suggested by some patent practitioners and commentators that "means-plus-function" language should be avoided, or at least that some claims which did not use "means-plus-function" language be included. I discussed this decision, and the law relating to "means-plus-function" claim elements generally with my own patent colleagues, and specifically with trial counsel as it related to the claims of the '734 and '947 patents. I concluded that broader claims would result from avoidance of these limitations, and realized that I had erroneously not presented claims during the prosecution of the '947 patent, although such claims could have been.

162. I explained to Mr. Beery that broader claims could result from avoidance of "means-plus-function" limitations, and that a claim which did not include "means-plus-function" limitations erroneously had not been presented during the prosecution of the '947 patent. I further recognized and suggested to Mr. Beery that a claim like claim 31 could have been presented during the prosecution of the '947 patent. Mr. Beery thereafter asked me to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

Claim 32

163. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the application for a control apparatus for a television receiver in which the apparatus could store channel designations in a plurality of ordered cues, and which included as elements "a tuner,"

"a memory," "an operator-actuated control device," and "a processor." It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 32 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

164. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions included a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that Mr. Beery could have presented claims to the feature for storing channel designations in multiple ordered cues independent of the operator-selected channel designation feature, and that Mr. Beery should consider the filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

165. At about the same time, I was prosecuting on Mr. Beery's behalf a reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Beery and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Beery and I discussed during this time that the feature for storing channel designations in multiple ordered cues could have been claimed independently, although no such claims had been presented in the application for the '947 patent.

166. In August 1993, Mr. Beery brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with his '734 patent.

167. In September 1993, a reissue application for the '947 patent was filed.

168. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Beery and I discussed the claims of the '947 patent as I prepared a response to the Office action.

169. Also during February of 1994, the CAFC issued its *In re Donaldson* decision (29 USPQ2d 1845), which required the PTO to interpret "means plus function" claim language as limited to the specific embodiment disclosed and equivalents thereof. Much attention was paid to this decision in the patent bar, and I recall that it was suggested by some patent practitioners and commentators that "means-plus-function" language should be avoided, or at least that some claims which did not use "means-plus-function" language be included. I discussed this decision, and the law relating to "means-plus-function" claim elements generally with my own patent colleagues, and specifically with trial counsel as it related to the claims of the '734 and '947 patents. I concluded that broader claims would result from avoidance of these limitations, and realized that I had erroneously not presented claims during the prosecution of the '947 patent, although such claims could have been.

170. I explained to Mr. Beery that broader claims could result from avoidance of "means-plus-function" limitations, and that a claim which did not include "means-plus-function" limitations erroneously had not been presented during the prosecution of the '947 patent. I further recognized and suggested to Mr. Beery that a claim like claim 32 could have been presented during the prosecution of the '947 patent. Mr. Beery thereafter asked me to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

Claim 33

171. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the

application for a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element, and which included as elements "a tuner," "a memory," "an operator-actuated control device," and "a processor." It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 33 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

172. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions included a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that Mr. Beery could have presented claims which did not include the tuning means as an element of the claims, and that Mr. Beery should consider the filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

173. At about the same time, I was prosecuting on Mr. Beery's behalf a reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Beery and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Beery and I discussed during this time that the tuning means was not a necessary limitation of claims directed to his invention, although no such claims had been presented in the application for the '947 patent.

174. In August 1993, Mr. Beery brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with his '734 patent.

175. In September 1993, a reissue application for the '947 patent was filed.

176. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Beery and I discussed the claims of the '947 patent as I prepared a response to the Office action.

177. Also during February of 1994, the CAFC issued its *In re Donaldson* decision (29 USPQ2d 1845), which required the PTO to interpret "means plus function" claim language as limited to the specific embodiment disclosed and equivalents thereof. Much attention was paid to this decision in the patent bar, and I recall that it was suggested by some patent practitioners and commentators that "means-plus-function" language should be avoided, or at least that some claims which did not use "means-plus-function" language be included. I discussed this decision, and the law relating to "means-plus-function" claim elements generally with my own patent colleagues, and specifically with trial counsel as it related to the claims of the '734 and '947 patents. I concluded that broader claims would result from avoidance of these limitations, and realized that I had erroneously not presented claims during the prosecution of the '947 patent, although such claims could have been.

178. I explained to Mr. Beery that broader claims could result from avoidance of "means-plus-function" limitations, and that a claim which did not include "means-plus-function" limitations erroneously had not been presented during the prosecution of the '947 patent. I further recognized and suggested to Mr. Beery that a claim like claim 33 could have been presented during the prosecution of the '947 patent. Mr. Beery thereafter asked me to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

Claim 34

179. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the application for a control apparatus for a television receiver that did not include a tuner for the television receiver as an element, and which included as elements "a tuner," "a memory," "an operator-actuated control device," and "a processor." It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 34 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

180. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions included a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that Mr. Beery could have presented claims which did not include the tuning means as an element of the claims, and that Mr. Beery should consider the filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

181. At about the same time, I was prosecuting on Mr. Beery's behalf a reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Beery and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Beery and I discussed during this time that the tuning means was not a

necessary limitation of claims directed to his invention, although no such claims had been presented in the application for the '947 patent.

182. In August 1993, Mr. Beery brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with his '734 patent.

183. In September 1993, a reissue application for the '947 patent was filed.

184. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Beery and I discussed the claims of the '947 patent as I prepared a response to the Office action.

185. Also during February of 1994, the CAFC issued its *In re Donaldson* decision (29 USPQ2d 1845), which required the PTO to interpret "means plus function" claim language as limited to the specific embodiment disclosed and equivalents thereof. Much attention was paid to this decision in the patent bar, and I recall that it was suggested by some patent practitioners and commentators that "means-plus-function" language should be avoided, or at least that some claims which did not use "means-plus-function" language be included. I discussed this decision, and the law relating to "means-plus-function" claim elements generally with my own patent colleagues, and specifically with trial counsel as it related to the claims of the '734 and '947 patents. I concluded that broader claims would result from avoidance of these limitations, and realized that I had erroneously not presented claims during the prosecution of the '947 patent, although such claims could have been.

186. I explained to Mr. Beery that broader claims could result from avoidance of "means-plus-function" limitations, and that a claim which did not include "means-plus-function" limitations erroneously had not been presented during the prosecution of the '947 patent. I further recognized and suggested to Mr. Beery that a claim like claim 34 could have been presented during the prosecution of the '947 patent. Mr. Beery thereafter asked me to include this claim

in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

Claim 35

187. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the application for a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element, and which included as elements "a tuner," "a memory," "an operator-actuated control device," and "a processor." It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 35 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

188. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions included a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that Mr. Beery could have presented claims which did not include the tuning means as an element of the claims, and that Mr. Beery should consider the filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

189. At about the same time, I was prosecuting on Mr. Beery's behalf a reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Beery and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Beery and I discussed during this time that the tuning means was not a necessary limitation of claims directed to his invention, although no such claims had been presented in the application for the '947 patent.

190. In August 1993, Mr. Beery brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with his '734 patent.

191. In September 1993, a reissue application for the '947 patent was filed.

192. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Beery and I discussed the claims of the '947 patent as I prepared a response to the Office action.

193. Also during February of 1994, the CAFC issued its *In re Donaldson* decision (29 USPQ2d 1845), which required the PTO to interpret "means plus function" claim language as limited to the specific embodiment disclosed and equivalents thereof. Much attention was paid to this decision in the patent bar, and I recall that it was suggested by some patent practitioners and commentators that "means-plus-function" language should be avoided, or at least that some claims which did not use "means-plus-function" language be included. I discussed this decision, and the law relating to "means-plus-function" claim elements generally with my own patent colleagues, and specifically with trial counsel as it related to the claims of the '734 and '947 patents. I concluded that broader claims would result from avoidance of these limitations, and realized that I had erroneously not presented claims during the prosecution of the '947 patent, although such claims could have been.

194. I explained to Mr. Beery that broader claims could result from avoidance of "means-plus-function" limitations, and that a claim which did not include "means-plus-function" limitations erroneously had not been presented during the prosecution of the '947 patent. I further recognized and suggested to Mr. Beery that a claim like claim 35 could have been presented during the prosecution of the '947 patent. Mr. Beery thereafter asked me to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

Claim 36

195. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the application for a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element, and which included as elements "a tuner," "a memory," "an operator-actuated control device," and "a processor." It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 36 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

196. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions included a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that Mr. Beery could have presented claims which did not include the tuning means as an

element of the claims, and that Mr. Beery should consider the filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

197. At about the same time, I was prosecuting on Mr. Beery's behalf a reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Beery and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Beery and I discussed during this time that the tuning means was not a necessary limitation of claims directed to his invention, although no such claims had been presented in the application for the '947 patent.

198. In August 1993, Mr. Beery brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with his '734 patent.

199. In September 1993, a reissue application for the '947 patent was filed.

200. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Beery and I discussed the claims of the '947 patent as I prepared a response to the Office action.

201. Also during February of 1994, the CAFC issued its *In re Donaldson* decision (29 USPQ2d 1845), which required the PTO to interpret "means plus function" claim language as limited to the specific embodiment disclosed and equivalents thereof. Much attention was paid to this decision in the patent bar, and I recall that it was suggested by some patent practitioners and commentators that "means-plus-function" language should be avoided, or at least that some claims which did not use "means-plus-function" language be included. I discussed this decision, and the law relating to "means-plus-function" claim elements generally with my own patent colleagues, and specifically with trial counsel as it related to the claims of the '734 and '947 patents. I concluded that broader claims would result from avoidance of these limitations, and

realized that I had erroneously not presented claims during the prosecution of the '947 patent, although such claims could have been.

202. I explained to Mr. Beery that broader claims could result from avoidance of "means-plus-function" limitations, and that a claim which did not include "means-plus-function" limitations erroneously had not been presented during the prosecution of the '947 patent. I further recognized and suggested to Mr. Beery that a claim like claim 36 could have been presented during the prosecution of the '947 patent. Mr. Beery thereafter asked me to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

Claim 37

203. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the application for a control apparatus for a television receiver in which the apparatus could store channel designations in a plurality of ordered cues, and which included as elements "a tuner," "a memory," "an operator-actuated control device," and "a processor." It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 37 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

204. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions

included a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that Mr. Beery could have presented claims to the feature for storing channel designations in an ordered cue independent of the operator-selected channel designation feature, and that Mr. Beery should consider the filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

205. At about the same time, I was prosecuting on Mr. Beery's behalf a reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Beery and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Beery and I discussed during this time that the feature for storing channel designations in multiple ordered cues could have been claimed independently, although no such claims had been presented in the application for the '947 patent.

206. In August 1993, Mr. Beery brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with his '734 patent.

207. In September 1993, a reissue application for the '947 patent was filed.

208. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Beery and I discussed the claims of the '947 patent as I prepared a response to the Office action.

209. Also during February of 1994, the CAFC issued its *In re Donaldson* decision (29 USPQ2d 1845), which required the PTO to interpret "means plus function" claim language as limited to the specific embodiment disclosed and equivalents thereof. Much attention was paid to this decision in the patent bar, and I recall that it was suggested by some patent practitioners and commentators that "means-plus-function" language should be avoided, or at least that some claims which did not use "means-plus-function" language be included. I discussed this decision,

and the law relating to "means-plus-function" claim elements generally with my own patent colleagues, and specifically with trial counsel as it related to the claims of the '734 and '947 patents. I concluded that broader claims would result from avoidance of these limitations, and realized that I had erroneously not presented claims during the prosecution of the '947 patent, although such claims could have been.

210. I explained to Mr. Beery that broader claims could result from avoidance of "means-plus-function" limitations, and that a claim which did not include "means-plus-function" limitations erroneously had not been presented during the prosecution of the '947 patent. I further recognized and suggested to Mr. Beery that a claim like claim 37 could have been presented during the prosecution of the '947 patent. Mr. Beery thereafter asked me to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

Claim 38

211. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the application for a control apparatus for a television receiver in which a memory clear signal can be used to restore, for one of the channel tuning designations, a channel select designation which is identical thereto. It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 38 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

212. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone

discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions included a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that Mr. Beery could have presented additional claims, and that Mr. Beery should consider the filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

213. At about the same time, I was prosecuting on Mr. Beery's behalf a reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Beery and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Beery and I discussed during this time that the tuning means was not a necessary limitation of claims directed to his invention, although no such claims had been presented in the application for the '947 patent.

214. In August 1993, Mr. Beery brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with his '734 patent.

215. In September 1993, a reissue application for the '947 patent was filed.

216. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Beery and I discussed the claims of the '947 patent as I prepared a response to the Office action.

217. At about this same time, Mr. Hokanson and I carefully reviewed numerous prior art citations which had been identified by defendants in the Gemstar litigation. Mr. Hokanson noted that a claim which included "means for storing at least one operator-assigned channel select designation for each of a plurality of said channel tuning designations," and the processor means is for clearing from said memory a selected one of said channel select designations and restoring

therein said channel select designation for a corresponding one of said channel tuning designations which is identical thereto" was helpful in explaining the manner in which Mr. Beery's invention worked, and how the accused device was the same as the patented invention. I then realized that a claim incorporating these elements could have been presented in the '947 application, but erroneously was not.

218. After discussing this recognition with Mr. Beery, he asked me to include a claim such as claim 38 in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

Claim 39

219. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the application for a control apparatus for a television receiver in which a memory clear signal can be used to restore, for one of the channel tuning designations, a channel select designation which is identical thereto, or for a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element. It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 39 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

220. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions included a careful review of the scope of the claims of the '734 and '947 patents. During these

discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that Mr. Beery could have presented claims which did not include the tuning means as an element of the claims, and that Mr. Beery should consider the filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

221. At about the same time, I was prosecuting on Mr. Beery's behalf a reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Beery and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Beery and I discussed during this time that the tuning means was not a necessary limitation of claims directed to his invention, although no such claims had been presented in the application for the '947 patent.

222. In August 1993, Mr. Beery brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with his '734 patent.

223. In September 1993, a reissue application for the '947 patent was filed.

224. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Beery and I discussed the claims of the '947 patent as I prepared a response to the Office action.

225. At about this same time, Mr. Hokanson and I carefully reviewed numerous prior art citations which had been identified by defendants in the Gemstar litigation. Mr. Hokanson noted that a claim which included "means for storing at least one operator-assigned channel select designation for each of a plurality of said channel tuning designations," and the processor means is for clearing from said memory a selected one of said channel select designations and restoring therein said channel select designation for a corresponding one of said channel tuning designations which is identical thereto" was helpful in explaining the manner in which Mr.

Beery's invention worked, and how the accused device was the same as the patented invention. I then realized that a claim incorporating these elements could have been presented in the '947 application, but erroneously was not.

226. After discussing this recognition with Mr. Beery, he asked me to include a claim such as claim 39 in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

Claim 40

227. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the application for a control apparatus for a television receiver in which the apparatus could store channel designations in a plurality of ordered scroll sequences. It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 40 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

228. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions included a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that Mr. Beery could have presented claims to the feature for storing channel designations in multiple ordered cues independent of the operator-selected channel designation feature, and that

Mr. Beery should consider the filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

229. At about the same time, I was prosecuting on Mr. Beery's behalf a reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Beery and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Beery and I discussed during this time that the feature for storing channel designations in multiple ordered cues could have been claimed independently, although no such claims had been presented in the application for the '947 patent.

230. In August 1993, Mr. Beery brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with his '734 patent.

231. In September 1993, a reissue application for the '947 patent was filed.

232. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Beery and I discussed the claims of the '947 patent as I prepared a response to the Office action.

233. At about this same time, as part of the work in connection with the Gemstar litigation, Mr. Hokanson and I carefully reviewed the specifications of the '734 and '947 patents, discussing each of the terms used within the specifications. With regard to the term "scroll sequence," Mr. Hokanson observed that this term could be interpreted differently than the term "cue" used in the claims of the '734 patent. I then realized that such claims could have been presented in the '947 application, but erroneously were not.

234. I advised Mr. Beery that such a claim had erroneously not been presented during the prosecution of the '947 patent, although such a claim could have been. Mr. Beery then asked

me to include a claim such as claim 40 in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

Claim 41

235. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the application for a control apparatus for a television receiver in which the apparatus could store channel designations in a plurality of ordered scroll sequences, and which includes means for generating a scroll sequence selection signal. It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 41 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

236. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery.

237. In the spring of 1993, I became aware of certain television sets sold by Hitachi Home Electronics (America), Inc. which I believed included a "favorite channel" feature in which channel designations were stored in multiple cues. I thereupon realized that this feature was something which I had invented, and that could be claimed independently of the operator-selected channel designation feature. I discussed this with Mr. Beery, who advised me that such claims could have been presented in the application for my '947 patent.

238. In August 1993, Mr. Beery brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with his '734 patent.

239. In September 1993, a reissue application for the '947 patent was filed.

240. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Beery and I discussed the claims of the '947 patent as he prepared a response to the Office action.

241. At about this same time, as part of the work in connection with the Gemstar litigation, Mr. Hokanson and I carefully reviewed the specifications of the '734 and '947 patents, discussing each of the terms used within the specifications. With regard to the term "scroll sequence," Mr. Hokanson observed that this term could be interpreted differently than the term "cue" used in the claims of the '734 patent. I then realized that such claims could have been presented in the '947 application, but erroneously were not.

242. I advised Mr. Beery that such a claim had erroneously not been presented during the prosecution of the '947 patent, although such a claim could have been. Mr. Beery then asked me to include a claim such as claim 41 in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

Claim 42

243. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the application for a control apparatus for a television receiver in which the apparatus could store channel designations in a plurality of scroll sequences. It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 42 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

244. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions included a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that Mr. Beery could have presented claims to the feature for storing channel designations in an ordered cue independent of the operator-selected channel designation feature, and that Mr. Beery should consider the filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

245. At about the same time, I was prosecuting on Mr. Beery's behalf a reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Beery and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Beery and I discussed during this time that the feature for storing channel designations in multiple ordered cues could have been claimed independently, although no such claims had been presented in the application for the '947 patent.

246. In August 1993, Mr. Beery brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with his '734 patent.

247. In September 1993, a reissue application for the '947 patent was filed.

248. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Beery and I discussed the claims of the '947 patent as he prepared a response to the Office action.

249. At about this same time, as part of the work in connection with the Gemstar litigation, Mr. Hokanson and I carefully reviewed the specifications of the '734 and '947 patents, discussing each of the terms used within the specifications. With regard to the term "scroll sequence," Mr. Hokanson observed that this term could be interpreted differently than the term "cue" used in the claims of the '734 patent. I then realized that such claims could have been presented in the '947 application, but erroneously were not.

250. I advised Mr. Beery that such a claim had erroneously not been presented during the prosecution of the '947 patent, although such a claim could have been. Mr. Beery then asked me to include a claim such as claim 42 in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

Claim 43

251. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the application for a control apparatus for a television receiver in which the apparatus could store channel designations in a plurality of ordered scroll sequences, and in which the processor performed operations "in response to" the presence of a particular signal. It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 43 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

252. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These

attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions included a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that Mr. Beery could have presented claims to the feature for storing channel designations in an ordered cue independent of the operator-selected channel designation feature, and that Mr. Beery should consider the filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

253. At about the same time, I was prosecuting on Mr. Beery's behalf a reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Beery and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Beery and I discussed during this time that the feature for storing channel designations in multiple ordered cues could have been claimed independently, although no such claims had been presented in the application for the '947 patent.

254. In August 1993, Mr. Beery brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with his '734 patent.

255. In September 1993, a reissue application for the '947 patent was filed.

256. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Beery and I discussed the claims of the '947 patent as he prepared a response to the Office action.

257. At about this same time, as part of the work in connection with the Gemstar litigation, Mr. Hokanson and I carefully reviewed the specifications of the '734 and '947 patents, discussing each of the terms used within the specifications. With regard to the term "scroll sequence," Mr. Hokanson observed that this term could be interpreted differently than the term "cue" used in the claims of the '734 patent.

258. At approximately this same time, Mr. Beery and I learned through Mr. Hokanson that Gemstar in the litigation had advanced the argument that its accused device did not infringe as a result of language "upon receipt of" which appeared in the claims of the '734 patent. Specifically, the Gemstar product received a data set which was representative of a channel select designation. However, because the Gemstar device is for the purpose of later recording programs on a VCR, some time would pass before the received data set was used to tune the channel in question. This separation in time, Gemstar argued, did not fall within the scope of the language "upon receipt of." While I did not then, and do not now, believe the Gemstar interpretation to be correct, Mr. Hokanson and I suggested to Mr. Beery that broader claims could have been presented in the application for the '947 patent using language such as "in response to," which language would be broader than the language "upon receipt of."

259. I then recognized that a claim such as claim 43 had erroneously not been presented during the prosecution of the '947 patent, although such a claim could have been. I advised Mr. Beery of this, and he then asked me to include a claim such as claim 43 in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

Claim 44

260. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the application for a control apparatus for a television receiver in which the apparatus could store channel designations in a plurality of ordered scroll sequences. It did not occur to me, and I

inadvertently failed to appreciate, that a claim in accord with claim 44 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

261. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions included a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that Mr. Beery could have presented additional claims relating to his invention, and that Mr. Beery should consider the filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

262. At about the same time, I was prosecuting on Mr. Beery's behalf a reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Beery and me to carefully study and discuss the claims of both the '734 and '947 patents.

263. In August 1993, Mr. Beery brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with his '734 patent.

264. In September 1993, a reissue application for the '947 patent was filed.

265. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Beery and I discussed the claims of the '947 patent as he prepared a response to the Office action.

266. At about this same time, as part of the work in connection with the Gemstar litigation, Mr. Hokanson and I carefully reviewed the specifications of the '734 and '947 patents, discussing each of the terms used within the specifications. With regard to the term "scroll sequence," Mr. Hokanson observed that this term could be interpreted differently than the term "cue" used in the claims of the '734 patent. I then realized that such claims could have been presented in the '947 application, but erroneously were not.

267. I advised Mr. Beery that such a claim had erroneously not been presented during the prosecution of the '947 patent, although such a claim could have been. Mr. Beery then asked me to include a claim such as claim 44 in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

Claim 45

268. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the application for a control apparatus for a television receiver in which the apparatus could store channel select designations and retrieve corresponding tuning designations "following receipt of" an appropriate data set. It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 45 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

269. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California.

Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions included a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that Mr. Beery could have presented additional claims, and that Mr. Beery should consider the filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

270. At about the same time, I was prosecuting on Mr. Beery's behalf a reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Beery and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Beery and I discussed during this time that the tuning means was not a necessary limitation of claims directed to his invention, although no such claims had been presented in the application for the '947 patent.

271. In August 1993, Mr. Beery brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with his '734 patent.

272. In September 1993, a reissue application for the '947 patent was filed.

273. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Beery and I discussed the claims of the '947 patent as he prepared a response to the Office action.

274. At approximately this same time (early 1994), Mr. Beery and I learned through Mr. Hokanson that Gemstar in the litigation had advanced the argument that its accused device did not infringe as a result of language "upon receipt of" which appeared in the claims of the '734

patent. Specifically, the Gemstar product received a data set which was representative of a channel select designation. However, because the Gemstar device is for the purpose of later recording programs on a VCR, some time would pass before the received data set was used to tune the channel in question. This separation in time, Gemstar argued, did not fall within the scope of the language "upon receipt of." While I did not then, and do not now, believe the Gemstar interpretation to be correct, Mr. Hokanson and I suggested to Mr. Beery that broader claims could have been presented in the application for the '947 patent using language such as "following receipt of," which language would be broader than the language "upon receipt of."

275. Mr. Beery then asked me to include a claim like claim 45 in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

Claim 46

276. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the application for a control apparatus for a television receiver in which the apparatus could store channel select designations and retrieve corresponding tuning designations "following receipt of" an appropriate data set. It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 46 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

277. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions

included a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that Mr. Beery could have presented additional claims, and that Mr. Beery should consider the filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

278. At about the same time, I was prosecuting on Mr. Beery's behalf a reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Beery and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Beery and I discussed during this time that the tuning means was not a necessary limitation of claims directed to his invention, although no such claims had been presented in the application for the '947 patent.

279. In August 1993, Mr. Beery brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with his '734 patent.

280. In September 1993, a reissue application for the '947 patent was filed.

281. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Beery and I discussed the claims of the '947 patent as he prepared a response to the Office action.

282. At approximately this same time (early 1994), Mr. Beery and I learned through Mr. Hokanson that Gemstar in the litigation had advanced the argument that its accused device did not infringe as a result of language "upon receipt of" which appeared in the claims of the '734 patent. Specifically, the Gemstar product received a data set which was representative of a channel select designation. However, because the Gemstar device is for the purpose of later recording programs on a VCR, some time would pass before the received data set was used to tune the channel in question. This separation in time, Gemstar argued, did not fall within the

scope of the language "upon receipt of." While I did not then, and do not now, believe the Gemstar interpretation to be correct, Mr. Hokanson and I suggested to Mr. Beery that broader claims could have been presented in the application for the '947 patent using language such as "following receipt of," which language would be broader than the language "upon receipt of."

283. Mr. Beery then asked me to include a claim like claim 46 in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

Claim 47

284. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the application for a control apparatus for a television receiver in which the apparatus could store channel select designations and retrieve corresponding tuning designations "following receipt of" an appropriate data set. It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 47 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

285. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions included a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that Mr. Beery could have presented additional claims, and that Mr. Beery should consider the

filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

286. At about the same time, I was prosecuting on Mr. Beery's behalf a reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Beery and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Beery and I discussed during this time that the tuning means was not a necessary limitation of claims directed to his invention, although no such claims had been presented in the application for the '947 patent.

287. In August 1993, Mr. Beery brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with his '734 patent.

288. In September 1993, a reissue application for the '947 patent was filed.

289. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Beery and I discussed the claims of the '947 patent as he prepared a response to the Office action.

290. At approximately this same time (early 1994), Mr. Beery and I learned through Mr. Hokanson that Gemstar in the litigation had advanced the argument that its accused device did not infringe as a result of language "upon receipt of" which appeared in the claims of the '734 patent. Specifically, the Gemstar product received a data set which was representative of a channel select designation. However, because the Gemstar device is for the purpose of later recording programs on a VCR, some time would pass before the received data set was used to tune the channel in question. This separation in time, Gemstar argued, did not fall within the scope of the language "upon receipt of." While I did not then, and do not now, believe the Gemstar interpretation to be correct, Mr. Hokanson and I suggested to Mr. Beery that broader claims could have been presented in the application for the '947 patent using language such as

"following receipt of," which language would be broader than the language "upon receipt of."

291. Mr. Beery then asked me to include a claim like claim 47 in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

Claim 48

292. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the application for a control apparatus for a television receiver in which the apparatus included a television screen as one of the claim elements. It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 48 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

293. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions included a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that Mr. Beery could have presented additional claims, and that Mr. Beery should consider the filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

294. At about the same time, I was prosecuting on Mr. Beery's behalf a reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination

which caused Mr. Beery and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Beery and I discussed during this time that the tuning means was not a necessary limitation of claims directed to his invention, although no such claims had been presented in the application for the '947 patent.

295. In August 1993, Mr. Beery brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with his '734 patent.

296. In September 1993, a reissue application for the '947 patent was filed.

297. In February 1994, an Office Action was mailed in connection with the present reissue application. During the period of approximately March through August 1994, Mr. Beery and I discussed the claims of the '947 patent as he prepared a response to the Office action.

298. At approximately this same time (early 1994), as part of our discussions of the Gemstar litigation, Mr. Hokanson suggested to me that perhaps a claim could have been presented in the application for the '947 patent that included a television screen as one of the claim elements. I then realized that a claim like that presented as claim 48 in this application could have been presented in the original application for the '947 patent, but erroneously was not.

299. I advised Mr. Beery of my realization, and he asked me to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the February 1994 Office action.

Claim 49

300. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the application a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element, and in which the processor performed operations "in

response to" the presence of a particular signal, or that stored "select codes" which corresponded to "channel codes," and in which the processor performed operations "in response to" the presence of a particular signal. It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 49 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

301. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions included a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that Mr. Beery could have presented claims which did not include the tuning means as an element of the claims, and that Mr. Beery should consider the filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

302. At about the same time, I was prosecuting on Mr. Beery's behalf a reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Beery and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Beery and I discussed during this time that the tuning means was not a necessary limitation of claims directed to his invention, although no such claims had been presented in the application for the '947 patent.

303. In August 1993, Mr. Beery brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with his '734 patent.

304. In September 1993, a reissue application for the '947 patent was filed.

305. In approximately early 1994, Mr. Beery and I learned through Mr. Hokanson that Gemstar in the litigation had advanced the argument that its accused device did not infringe as a result of language "upon receipt of" which appeared in the claims of the '734 patent. Specifically, the Gemstar product received a data set which was representative of a channel select designation. However, because the Gemstar device is for the purpose of later recording programs on a VCR, some time would pass before the received data set was used to tune the channel in question. This separation in time, Gemstar argued, did not fall within the scope of the language "upon receipt of." While I did not then, and do not now, believe the Gemstar interpretation to be correct, Mr. Hokanson and I suggested to Mr. Beery that broader claims could have been presented in the application for the '947 patent using language such as "in response to," which language would be broader than the language "upon receipt of."

306. At about this same time, as part of the work in connection with the Gemstar litigation, Mr. Hokanson and I carefully reviewed the specifications of the '734 and '947 patents, discussing each of the terms used within the specifications. With regard to the terms "channel code" and "select code," both used in the specification, Mr. Hokanson observed that although these terms were narrower than those already used in the claims ("channel tuning designation" and "channel select designation"), the terms were not found in any of the claims of the '734 or '947 patents.

307. During November 1994, in anticipation of a further office action in this application, and in December 1994 following receipt of the Office Action dated December 9, 1994, I reviewed once again the claims of the application and the '734 and '947 patents to try to identify any claims which should have been presented in the '947 patent but which had so far been

overlooked. As a result of my review, I drafted claim 49 which used as claim language the terms "channel code" and "select code."

308. In December 1994, a second Office Action was mailed in connection with the present reissue application. During December and early the following January, Mr. Beery and I discussed the claims of the '947 patent as I prepared a response to the Office action. I advised Mr. Beery that claim 49 could have been presented in the application for the '947 patent in which the language "select code" and "channel code" was used instead of "select designation" and "tuning designation." I further advised that this language appears in the '947 specification, and that it could serve as a hedge in the event that other, broader claims might later be found invalid. I also suggested that such a claim could use the language "in response to" rather than "upon receipt of."

309. Mr. Beery thereafter asked me to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the December 1994 Office action.

Claim 50

310. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the application for a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element, and in which the processor performed operations "in response to" the presence of a particular signal, or that stored "select codes" which corresponded to "channel codes." It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 50 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

311. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These

attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions included a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that Mr. Beery could have presented claims which did not include the tuning means as an element of the claims, and that Mr. Beery should consider the filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

312. At about the same time, I was prosecuting on Mr. Beery's behalf a reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Beery and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Beery and I discussed during this time that the tuning means was not a necessary limitation of claims directed to his invention, although no such claims had been presented in the application for the '947 patent.

313. In August 1993, Mr. Beery brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with his '734 patent.

314. In September 1993, a reissue application for the '947 patent was filed.

315. In approximately early 1994, Mr. Beery and I learned through Mr. Hokanson that Gemstar in the litigation had advanced the argument that its accused device did not infringe as a result of language "upon receipt of" which appeared in the claims of the '734 patent. Specifically, the Gemstar product received a data set which was representative of a channel select designation. However, because the Gemstar device is for the purpose of later recording

programs on a VCR, some time would pass before the received data set was used to tune the channel in question. This separation in time, Gemstar argued, did not fall within the scope of the language "upon receipt of." While I did not then, and do not now, believe the Gemstar interpretation to be correct, Mr. Hokanson and I suggested to Mr. Beery that broader claims could have been presented in the application for the '947 patent using language such as "in response to," which language would be broader than the language "upon receipt of."

316. At about this same time, as part of the work in connection with the Gemstar litigation, Mr. Hokanson and I carefully reviewed the specifications of the '734 and '947 patents, discussing each of the terms used within the specifications. With regard to the terms "channel code" and "select code," both used in the specification, Mr. Hokanson observed that although these terms were narrower than those already used in the claims ("channel tuning designation" and "channel select designation"), the terms were not found in any of the claims of the '734 or '947 patents.

317. During November 1994, in anticipation of a further office action in this application, and in December 1994 following receipt of the Office Action dated December 9, 1994, I reviewed once again the claims of the application and the '734 and '947 patents to try to identify any claims which should have been presented in the '947 patent but which had so far been overlooked. As a result of my review, I drafted claim 50 which used as claim language the terms "channel code" and "select code."

318. In December 1994, a second Office Action was mailed in connection with the present reissue application. During December and early the following January, Mr. Beery and I discussed the claims of the '947 patent as I prepared a response to the Office action. I advised Mr. Beery that claim 50 could have been presented in the application for the '947 patent in which the language "select code" and "channel code" was used instead of "select designation" and "tuning designation." I further advised that this language appears in the '947 specification, and that it could serve as a hedge in the event that other, broader claims might later be found

invalid. I also suggested that such a claim could use the language "in response to" rather than "upon receipt of."

319. Mr. Beery thereafter asked me to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the December 1994 Office action.

Claim 51

320. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the application for a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element, and in which the processor performed operations "in response to" the presence of a particular signal, or that stored "select codes" which corresponded to "channel codes." It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 51 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

321. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions included a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that Mr. Beery could have presented claims which did not include the tuning means as an element of the claims, and that Mr. Beery should consider the filing of an application to reissue

one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

322. At about the same time, I was prosecuting on Mr. Beery's behalf a reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Beery and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Beery and I discussed during this time that the tuning means was not a necessary limitation of claims directed to his invention, although no such claims had been presented in the application for the '947 patent.

323. In August 1993, Mr. Beery brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with his '734 patent.

324. In September 1993, a reissue application for the '947 patent was filed.

325. In approximately early 1994, Mr. Beery and I learned through Mr. Hokanson that Gemstar in the litigation had advanced the argument that its accused device did not infringe as a result of language "upon receipt of" which appeared in the claims of the '734 patent. Specifically, the Gemstar product received a data set which was representative of a channel select designation. However, because the Gemstar device is for the purpose of later recording programs on a VCR, some time would pass before the received data set was used to tune the channel in question. This separation in time, Gemstar argued, did not fall within the scope of the language "upon receipt of." While I did not then, and do not now, believe the Gemstar interpretation to be correct, Mr. Hokanson and I suggested to Mr. Beery that broader claims could have been presented in the application for the '947 patent using language such as "in response to," which language would be broader than the language "upon receipt of."

326. At about this same time, as part of the work in connection with the Gemstar litigation, Mr. Hokanson and I carefully reviewed the specifications of the '734 and '947 patents,

discussing each of the terms used within the specifications. With regard to the terms "channel code" and "select code," both used in the specification, Mr. Hokanson observed that although these terms were narrower than those already used in the claims ("channel tuning designation" and "channel select designation"), the terms were not found in any of the claims of the '734 or '947 patents.

327. During November 1994, in anticipation of a further office action in this application, and in December 1994 following receipt of the Office Action dated December 9, 1994, I reviewed once again the claims of the application and the '734 and '947 patents to try to identify any claims which should have been presented in the '947 patent but which had so far been overlooked. As a result of my review, I drafted claim 51 which used as claim language the terms "channel code" and "select code."

328. In December 1994, a second Office Action was mailed in connection with the present reissue application. During December and early the following January, Mr. Beery and I discussed the claims of the '947 patent as I prepared a response to the Office action. I advised Mr. Beery that claim 51 could have been presented in the application for the '947 patent in which the language "select code" and "channel code" was used instead of "select designation" and "tuning designation." I further advised that this language appears in the '947 specification, and that it could serve as a hedge in the event that other, broader claims might later be found invalid. I also suggested that such a claim could use the language "in response to" rather than "upon receipt of."

329. Mr. Beery thereafter asked me to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the December 1994 Office action.

Claim 52

330. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the

application for a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element, and in which the processor performed operations "in response to" the presence of a particular signal, or that stored "select codes" which corresponded to "channel codes." It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 52 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

331. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions included a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that Mr. Beery could have presented claims which did not include the tuning means as an element of the claims, and that Mr. Beery should consider the filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

332. At about the same time, I was prosecuting on Mr. Beery's behalf a reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Beery and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Beery and I discussed during this time that the tuning means was not a necessary limitation of claims directed to his invention, although no such claims had been presented in the application for the '947 patent.

333. In August 1993, Mr. Beery brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with his '734 patent.

334. In September 1993, a reissue application for the '947 patent was filed.

335. In approximately early 1994, Mr. Beery and I learned through Mr. Hokanson that Gemstar in the litigation had advanced the argument that its accused device did not infringe as a result of language "upon receipt of" which appeared in the claims of the '734 patent. Specifically, the Gemstar product received a data set which was representative of a channel select designation. However, because the Gemstar device is for the purpose of later recording programs on a VCR, some time would pass before the received data set was used to tune the channel in question. This separation in time, Gemstar argued, did not fall within the scope of the language "upon receipt of." While I did not then, and do not now, believe the Gemstar interpretation to be correct, Mr. Hokanson and I suggested to Mr. Beery that broader claims could have been presented in the application for the '947 patent using language such as "in response to," which language would be broader than the language "upon receipt of."

336. At about this same time, as part of the work in connection with the Gemstar litigation, Mr. Hokanson and I carefully reviewed the specifications of the '734 and '947 patents, discussing each of the terms used within the specifications. With regard to the terms "channel code" and "select code," both used in the specification, Mr. Hokanson observed that although these terms were narrower than those already used in the claims ("channel tuning designation" and "channel select designation"), the terms were not found in any of the claims of the '734 or '947 patents.

337. During November 1994, in anticipation of a further office action in this application, and in December 1994 following receipt of the Office Action dated December 9, 1994, I reviewed once again the claims of the application and the '734 and '947 patents to try to identify any claims which should have been presented in the '947 patent but which had so far been

overlooked. As a result of my review, I drafted claim 52 which used as claim language the terms "channel code" and "select code."

338. In December 1994, a second Office Action was mailed in connection with the present reissue application. During December and early the following January, Mr. Beery and I discussed the claims of the '947 patent as I prepared a response to the Office action. I advised Mr. Beery that claim 52 could have been presented in the application for the '947 patent in which the language "select code" and "channel code" was used instead of "select designation" and "tuning designation." I further advised that this language appears in the '947 specification, and that it could serve as a hedge in the event that other, broader claims might later be found invalid. I also suggested that such a claim could use the language "in response to" rather than "upon receipt of."

339. Mr. Beery thereafter asked me to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the December 1994 Office action.

Claim 53

340. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the application for a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element, and in which the processor performed operations "in response to" the presence of a particular signal, or wherein the "channel tuning designation" is defined as being "in a first series," and the "channel select designation" is defined as being "in a second series." It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 53 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

341. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with

an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions included a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that Mr. Beery could have presented claims which did not include the tuning means as an element of the claims, and that Mr. Beery should consider the filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

342. At about the same time, I was prosecuting on Mr. Beery's behalf a reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Beery and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Beery and I discussed during this time that the tuning means was not a necessary limitation of claims directed to his invention, although no such claims had been presented in the application for the '947 patent.

343. In August 1993, Mr. Beery brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with his '734 patent.

344. In September 1993, a reissue application for the '947 patent was filed.

345. In approximately early 1994, Mr. Beery and I learned through Mr. Hokanson that Gemstar in the litigation had advanced the argument that its accused device did not infringe as a result of language "upon receipt of" which appeared in the claims of the '734 patent. Specifically, the Gemstar product received a data set which was representative of a channel

select designation. However, because the Gemstar device is for the purpose of later recording programs on a VCR, some time would pass before the received data set was used to tune the channel in question. This separation in time, Gemstar argued, did not fall within the scope of the language "upon receipt of." While I did not then, and do not now, believe the Gemstar interpretation to be correct, Mr. Hokanson and I suggested to Mr. Beery that broader claims could have been presented in the application for the '947 patent using language such as "in response to," which language would be broader than the language "upon receipt of."

346. At about this same time, Mr. Hokanson and I carefully reviewed numerous prior art citations which had been identified by defendants in the Gemstar litigation. Mr. Hokanson noted that the "channel tuning designations" could be defined as being in a "first series" and the "channel select designations" could be defined as being in a "second series," and that this could be helpful in explaining the manner in which applicant's invention worked, how it differed from the prior art, and how the accused device was the same as the patented invention. I then realized that claims incorporating these terms were not found in either of the '734 or '947 patents. Such claims could have been presented in the '947 application, but erroneously were not.

347. During November 1994, in anticipation of a further office action in this application, and in December 1994 following receipt of the Office Action dated December 9, 1994, I reviewed once again the claims of the application and the '734 and '947 patents to try to identify any claims which should have been presented in the '947 patent but which had so far been overlooked. As a result of my review, I drafted claim 53 which used as claim language the terms "first series" and "second series."

348. In December 1994, a second Office Action was mailed in connection with the present reissue application. During December and early the following January, Mr. Beery and I discussed the claims of the '947 patent as I prepared a response to the Office action. I advised Mr. Beery that Mr. Hokanson had expressed the view that the "channel tuning designations"

could be defined as being in a "first series" and the "channel select designations" could be defined as being in a "second series," and that I had concluded that claims using this language could have been presented in the application for the '947 patent, and that such claims could serve as a hedge in the event that other, broader claims might later be found invalid.

349. I further discussed with Mr. Beery my realization that a claim like that presented as claim 53 in this application could have been presented in the original application for the '947 patent, but erroneously was not. Mr. Beery then asked me to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the December 1994 Office action.

Claim 54

350. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the application for a control apparatus for a television receiver that did not include a tuner means for the television receiver as an element, and in which the processor performed operations "in response to" the presence of a particular signal, or wherein the "channel tuning designation" is defined as being "in a first series," the "channel select designation" is defined as being "in a second series," and the "channel display designation" is defined as being "in a third series." It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 54 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

351. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone

discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions included a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that Mr. Beery could have presented claims which did not include the tuning means as an element of the claims, and that Mr. Beery should consider the filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

352. At about the same time, I was prosecuting on Mr. Beery's behalf a reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Beery and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Beery and I discussed during this time that the tuning means was not a necessary limitation of claims directed to his invention, although no such claims had been presented in the application for the '947 patent.

353. In August 1993, Mr. Beery brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with his '734 patent.

354. In September 1993, a reissue application for the '947 patent was filed.

355. In approximately early 1994, Mr. Beery and I learned through Mr. Hokanson that Gemstar in the litigation had advanced the argument that its accused device did not infringe as a result of language "upon receipt of" which appeared in the claims of the '734 patent. Specifically, the Gemstar product received a data set which was representative of a channel select designation. However, because the Gemstar device is for the purpose of later recording programs on a VCR, some time would pass before the received data set was used to tune the channel in question. This separation in time, Gemstar argued, did not fall within the scope of the language "upon receipt of." While I did not then, and do not now, believe the Gemstar

interpretation to be correct, Mr. Hokanson and I suggested to Mr. Beery that broader claims could have been presented in the application for the '947 patent using language such as "in response to," which language would be broader than the language "upon receipt of."

356. At about this same time, Mr. Hokanson and I carefully reviewed numerous prior art citations which had been identified by defendants in the Gemstar litigation. Mr. Hokanson noted that the "channel tuning designations" could be defined as being in a "first series," the "channel select designations" could be defined as being in a "second series," and the "channel display designations" could be defined as being in a "third series," and that this could be helpful in explaining the manner in which applicant's invention worked, how it differed from the prior art, and how the accused device was the same as the patented invention. I then realized that claims incorporating these terms were not found in either of the '734 or '947 patents. Such claims could have been presented in the '947 application, but erroneously were not.

357. During November 1994, in anticipation of a further office action in this application, and in December 1994 following receipt of the Office Action dated December 9, 1994, I reviewed once again the claims of the application and the '734 and '947 patents to try to identify any claims which should have been presented in the '947 patent but which had so far been overlooked. As a result of my review, I drafted claim 54 which used as claim language the terms "first series," "second series" and "third series."

358. In December 1994, a second Office Action was mailed in connection with the present reissue application. During December and early the following January, Mr. Beery and I discussed the claims of the '947 patent as I prepared a response to the Office action. I advised Mr. Beery that Mr. Hokanson had expressed the view that the "channel tuning designations" could be defined as being in a "first series," the "channel select designations" could be defined as being in a "second series," and the "channel display designations" could be defined as being in a "third series." I further advised that I had concluded that claims using this language could

have been presented in the application for the '947 patent, and that such claims could serve as a hedge in the event that other, broader claims might later be found invalid.

359. I further discussed with Mr. Beery my realization that a claim like that presented as claim 54 in this application could have been presented in the original application for the '947 patent, but erroneously was not. Mr. Beery then asked me to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the December 1994 Office action.

Claim 55

360. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the application to a method of controlling a television receiver, in particular one in which certain steps of the method are performed by a "first" and a "second" person. It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 55 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

361. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view of the merits of the case, and their possible representation of Mr. Beery. These discussions included a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that Mr. Beery could have presented a method claim as a way of protecting his invention, and

that Mr. Beery should consider the filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

362. At about the same time, I was prosecuting on Mr. Beery's behalf a reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Beery and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Beery and I discussed during this time that his invention could be defined in terms of a method claim, although no such claim had been presented in the application for the '947 patent.

363. In August 1993, Mr. Beery brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with his '734 patent.

364. In September 1993, a reissue application for the '947 patent was filed.

365. In October 1994, a summary judgement hearing relating to infringement had been held in the Gemstar litigation, at which a prominent issue was the identity of the various persons who could operate the device during various portions of its operation. Specifically, in the accused device, channel select designations could be chosen by someone other than the operator using the device to control the television receiver. As a result of discussions with Mr. Hokanson and review of related court papers, I realized that although discussed in the specification, there was nothing in the claims which related to various operations of the device being carried out by different persons. I further realized that such claims could have been presented in the '947 application, but erroneously were not.

366. During November 1994, in anticipation of a further office action in this application, and in December 1994 following receipt of the Office Action dated December 9, 1994, I reviewed I drafted claim 55. In December 1994, a second Office Action was mailed in connection with the present reissue application. During December and early the following January, Mr. Beery

and I discussed the claims of the '947 patent as I prepared a response to the Office action. I advised Mr. Beery that Mr. Hokanson and I were of the view that a method claim like claim 55 which clearly specified that certain steps in the method were carried out by a "first person" and a "second person" would be helpful in clarifying the manner in which some embodiments of his invention worked, how the accused device was the same as his invention, and could serve as a hedge in the event that other, broader claims might later be found invalid.

367. After further discussing with Mr. Beery my realization that a claim like that presented as claim 55 in this application could have been presented in the original application for the '947 patent, but erroneously was not, Mr. Beery asked me to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the December 1994 Office action.

Claim 56

368. During the time in which the application for the '947 patent was prepared and prosecuted, Mr. Beery did not discuss with me the possibility that a claim could have been presented in the application to a method of controlling a television receiver, in particular one in which certain steps of the method are performed by a "first" and a "second" person. It did not occur to me, and I inadvertently failed to appreciate, that a claim in accord with claim 56 was within the scope of Mr. Beery's invention, and that it should have been presented in the application for the '947 patent.

369. During the months of January through about March of 1993, Mr. Beery and I interviewed several attorneys about the possibility of representing Mr. Beery in connection with an infringement matter involving Gemstar Development Corp. and the '734 patent. These attorneys included Jon E. Hokanson and Patrick F. Bright, both of Los Angeles, California. Mr. Beery and I travelled to California in early January 1993 and met first with Mr. Hokanson, and then separately with Mr. Bright, in their offices. We also had a number of telephone discussions with them during January, February and March 1993 concerning the case, their view

of the merits of the case, and their possible representation of Mr. Beery. These discussions included a careful review of the scope of the claims of the '734 and '947 patents. During these discussions, it was suggested by either Mr. Hokanson or Mr. Bright (I do not remember which) that Mr. Beery could have presented a method claim as a way of protecting his invention, and that Mr. Beery should consider the filing of an application to reissue one or the other of his patents. I also advised Mr. Beery that he should consider a reissue application.

370. At about the same time, I was prosecuting on Mr. Beery's behalf a reexamination of the '734 patent. During the early part of 1993, an Office action was received in the reexamination which caused Mr. Beery and me to carefully study and discuss the claims of both the '734 and '947 patents. Mr. Beery and I discussed during this time that his invention could be defined in terms of a method claim, although no such claim had been presented in the application for the '947 patent.

371. In August 1993, Mr. Beery brought an infringement action against Gemstar Development Corp. and Hitachi Home Electronics (America), Inc. in connection with his '734 patent.

372. In September 1993, a reissue application for the '947 patent was filed.

373. In October 1994, a summary judgement hearing relating to infringement had been held in the Gemstar litigation, at which a prominent issue was the identity of the various persons who could operate the device during various portions of its operation. Specifically, in the accused device, channel select designations could be chosen by someone other than the operator using the device to control the television receiver. As a result of discussions with Mr. Hokanson and review of related court papers, I realized that although discussed in the specification, there was nothing in the claims which related to various operations of the device being carried out by different persons. I further realized that such claims could have been presented in the '947 application, but erroneously were not.

374. During November 1994, in anticipation of a further office action in this application, and in December 1994 following receipt of the Office Action dated December 9, 1994, I reviewed I drafted claim 56. In December 1994, a second Office Action was mailed in connection with the present reissue application. During December and early the following January, Mr. Beery and I discussed the claims of the '947 patent as I prepared a response to the Office action. I advised Mr. Beery that Mr. Hokanson and I were of the view that a method claim like claim 55 which clearly specified that certain steps in the method were carried out by a "first person" and a "second person" would be helpful in clarifying the manner in which some embodiments of his invention worked, how the accused device was the same as his invention, and could serve as a hedge in the event that other, broader claims might later be found invalid.

375. After further discussing with Mr. Beery my realization that a claim like that presented as claim 56 in this application could have been presented in the original application for the '947 patent, but erroneously was not, Mr. Beery asked me to include this claim in the application for reissue of the '947 patent by way of an amendment filed in response to the December 1994 Office action.

Errors in the Specification

Column 4, lines 25-26

376. I personally typed the specification for the application for the '947 patent. I also personally typed the specification for his '734 patent. Because most of the specification is identical to that of the '734 patent, I electronically copied the '734 specification using his word processing system into the specification of the application for the '947 patent. I had first made the typographical error identified above while typing the '734 specification, and this error was copied into and repeated in the new application.

377. During the early part of 1994, Mr. Beery, Mr. Hokanson and I met in connection with work on the Gemstar litigation. During our meeting, Mr. Hokanson and I together carefully read through the specification of the '734 patent, and discovered an identical error to that

identified above in the '734 specification. Because of the manner in which the specification for the '947 patent was prepared, I realized that the same error was likely to be found in the '947 patent. I then reviewed the '947 patent, and found the above-described error.

Column 9, line 14

378. I personally typed the specification for the application for the '947 patent. I also personally typed the specification for his '734 patent. Because most of the specification is identical to that of the '734 patent, I electronically copied the '734 specification using his word processing system into the specification of the application for the '947 patent. I had first made the typographical error identified above while typing the '734 specification, and this error was copied into and repeated in the new application.

379. During the early part of 1994, Mr. Beery, Mr. Hokanson and I met in connection with work on the Gemstar litigation. During our meeting, Mr. Hokanson and I together carefully read through the specification of the '734 patent, and discovered an identical error to that identified above in the '734 specification. Because of the manner in which the specification for the '947 patent was prepared, I realized that the same error was likely to be found in the '947 patent. I then reviewed the '947 patent, and found the above-described error.

Column 9, line 53

380. I personally typed the specification for the application for the '947 patent. I also personally typed the specification for his '734 patent. Because most of the specification is identical to that of the '734 patent, I electronically copied the '734 specification using his word processing system into the specification of the application for the '947 patent. I had first made the typographical error identified above while typing the '734 specification, and this error was copied into and repeated in the new application.

381. During the early part of 1994, Mr. Beery, Mr. Hokanson and I met in connection with work on the Gemstar litigation. During our meeting, Mr. Hokanson and I together carefully

read through the specification of the '734 patent, and discovered an identical error to that identified above in the '734 specification. Because of the manner in which the specification for the '947 patent was prepared, I realized that the same error was likely to be found in the '947 patent. I then reviewed the '947 patent, and found the above-described error.

Column 10, lines 58

382. I personally typed the specification for the application for the '947 patent. I also personally typed the specification for his '734 patent. Because most of the specification is identical to that of the '734 patent, I electronically copied the '734 specification using his word processing system into the specification of the application for the '947 patent. I had first made the typographical error identified above while typing the '734 specification, and this error was copied into and repeated in the new application.

383. During the early part of 1994, Mr. Beery, Mr. Hokanson and I met in connection with work on the Gemstar litigation. During our meeting, Mr. Hokanson and I together carefully read through the specification of the '734 patent, and discovered an identical error to that identified above in the '734 specification. Because of the manner in which the specification for the '947 patent was prepared, I realized that the same error was likely to be found in the '947 patent. I then reviewed the '947 patent, and found the above-described error.

Column 11, lines 38-39

384. I personally typed the specification for the application for the '947 patent. I also personally typed the specification for his '734 patent. Because most of the specification is identical to that of the '734 patent, I electronically copied the '734 specification using his word processing system into the specification of the application for the '947 patent. I had first made the typographical error identified above while typing the '734 specification, and this error was copied into and repeated in the new application.

385. During the early part of 1994, Mr. Beery, Mr. Hokanson and I met in connection with work on the Gemstar litigation. During our meeting, Mr. Hokanson and I together carefully

read through the specification of the '734 patent, and discovered an identical error to that identified above in the '734 specification. Because of the manner in which the specification for the '947 patent was prepared, I realized that the same error was likely to be found in the '947 patent. I then reviewed the '947 patent, and found the above-described error.

Column 11, lines 39-40

386. I personally typed the specification for the application for the '947 patent. I also personally typed the specification for his '734 patent. Because most of the specification is identical to that of the '734 patent, I electronically copied the '734 specification using his word processing system into the specification of the application for the '947 patent. I had first made the typographical error identified above while typing the '734 specification, and this error was copied into and repeated in the new application.

387. During the early part of 1994, Mr. Beery, Mr. Hokanson and I met in connection with work on the Gemstar litigation. During our meeting, Mr. Hokanson and I together carefully read through the specification of the '734 patent, and discovered an identical error to that identified above in the '734 specification. Because of the manner in which the specification for the '947 patent was prepared, I realized that the same error was likely to be found in the '947 patent. I then reviewed the '947 patent, and found the above-described error.

Column 12, line 19

388. I personally typed the specification for the application for the '947 patent. I also personally typed the specification for his '734 patent. Because most of the specification is identical to that of the '734 patent, I electronically copied the '734 specification using his word processing system into the specification of the application for the '947 patent. I had first made the typographical error identified above while typing the '734 specification, and this error was copied into and repeated in the new application.

389. During the early part of 1994, Mr. Beery, Mr. Hokanson and I met in connection with work on the Gemstar litigation. During our meeting, Mr. Hokanson and I together carefully

read through the specification of the '734 patent, and discovered an identical error to that identified above in the '734 specification. Because of the manner in which the specification for the '947 patent was prepared, I realized that the same error was likely to be found in the '947 patent. I then reviewed the '947 patent, and found the above-described error.

Column 12, line 21

390. I personally typed the specification for the application for the '947 patent. I also personally typed the specification for his '734 patent. Because most of the specification is identical to that of the '734 patent, I electronically copied the '734 specification using his word processing system into the specification of the application for the '947 patent. I had first made the typographical error identified above while typing the '734 specification, and this error was copied into and repeated in the new application.

391. During the early part of 1994, Mr. Beery, Mr. Hokanson and I met in connection with work on the Gemstar litigation. During our meeting, Mr. Hokanson and I together carefully read through the specification of the '734 patent, and discovered an identical error to that identified above in the '734 specification. Because of the manner in which the specification for the '947 patent was prepared, I realized that the same error was likely to be found in the '947 patent. I then reviewed the '947 patent, and found the above-described error.

Column 12, line 28

392. I personally typed the specification for the application for the '947 patent. I also personally typed the specification for his '734 patent. Because most of the specification is identical to that of the '734 patent, I electronically copied the '734 specification using his word processing system into the specification of the application for the '947 patent. I had first made the typographical error identified above while typing the '734 specification, and this error was copied into and repeated in the new application.

393. During the early part of 1994, Mr. Beery, Mr. Hokanson and I met in connection with work on the Gemstar litigation. During our meeting, Mr. Hokanson and I together carefully

read through the specification of the '734 patent, and discovered an identical error to that identified above in the '734 specification. Because of the manner in which the specification for the '947 patent was prepared, I realized that the same error was likely to be found in the '947 patent. I then reviewed the '947 patent, and found the above-described error.

Column 12, lines 29-30

394. I personally typed the specification for the application for the '947 patent. I also personally typed the specification for his '734 patent. Because most of the specification is identical to that of the '734 patent, I electronically copied the '734 specification using his word processing system into the specification of the application for the '947 patent. I had first made the typographical error identified above while typing the '734 specification, and this error was copied into and repeated in the new application.

395. During the early part of 1994, Mr. Beery, Mr. Hokanson and I met in connection with work on the Gemstar litigation. During our meeting, Mr. Hokanson and I together carefully read through the specification of the '734 patent, and discovered an identical error to that identified above in the '734 specification. Because of the manner in which the specification for the '947 patent was prepared, I realized that the same error was likely to be found in the '947 patent. I then reviewed the '947 patent, and found the above-described error.

I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under §1001 of Title 18 of the United States Code,

Serial No. 08/116,019

Page 102

and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.



Thomas A. Boshinski



Date